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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,425	07/29/2003	Herbert Muller	021123-0257987/970044CK	4172

25461 7590 12/08/2004
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EXAMINER
NGUYEN, CAM N

ART UNIT 1754	PAPER NUMBER
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DATE MAILED: 12/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/628,425

Applicant(s)

MULLER ET AL.

Examiner

Cam N Nguyen

Art Unit

1754

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on September 07, 2004 (an amendment/respons.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34-38, 44-50, 58, & 60-61 is/are rejected.
- 7) ☒ Claim(s) 34, 39-43, 51-57 and 59 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Applicants' remarks and amendments, filed on September 07, 2004, have been carefully considered. Claims 34-60 have been amended. New claim 61 has been added.

Claims 34-61 are now pending in this application and under consideration.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in GERMANY on 09/30/97. It is noted, however, that applicant has not filed a certified copy of the foreign application as required by 35 U.S.C. 119(b).

A certified copy of document 19743100.9 is required in reply to this office action.

Claim Objections

3. Claim 34 is objected to because of the following informalities: In line 3, a comma -- , -- should be inserted before "the suspension". Appropriate correction is required.

Claim Rejections - 35 USC § 112 (Second Paragraph)

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 49 & 50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 49 & 50 recite the limitation "said oxide" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 34-38, 44-48, 58, & 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seagraves (US Pat. 4,212,824) in view of Durand et al., "hereinafter Durand", (US Pat. 5,723,403).

Seagraves discloses a process for preparing a hydrogenation catalyst which comprises: (a) depositing onto carbon black particles having a surface area of less than about 300 m²/g, and oxide, hydroxide, or carbonate of platinum, the concentration of the platinum being in the range of about 0.1-10 percent by weight based on the weight of the carbon black, etc.; (b) depositing an oxide, hydroxide or carbonate of iron onto the carbon black particles in an amount to provide a molar ratio of iron to platinum in the range of about 1:1-16:1, and (c) reducing the platinum oxide, hydroxide or carbonate to platinum metal at a temperature less than about 35°C (see col. 13, claims 1-2).

Seagraves further discloses the concentration of platinum is about 1-5 weight percent and the surface area of the carbon black is in the range of from 20-100 m²/g (see col. 13, claim 5). The carbon black support is nonporous (see col. 3, ln 44). The process is carried out in an aqueous medium starting with an aqueous slurry of the nonporous carbon particles to which is added, in any order, a water-soluble platinum compound, etc., and a water-soluble iron compound (see col. 3, ln 42-46).

Seagraves does not disclose (ii), which is a water insoluble coating compound selected from the group consisting of SiO₂, Al₂O₃, TiO₂ and ZrO₂.

However, it would have been *prima facie obvious* to one of ordinary skill in the art at the time the invention was made to have incorporated such water insoluble coating compounds into the process of Seagraves in order to achieve a stable structure catalyst or to result in catalyst having an enhanced mechanical strength, because they are known and taught by Durand as useful catalyst support materials or coating compounds (see Durand at col. 10, claim 13).

Claim Rejections - 35 USC § 102(e)/103

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 61 is rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Freund et al., "hereinafter Freund", (US Pat. 5,900,386).

Freund discloses the claimed shell type catalyst, thus anticipates the claim.

Product-by-process limitation is the claim is noted. While the catalyst is not made by the same process, the catalyst disclosed is the same as the claimed, thus anticipates the claim. Further, it has been held that "even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even the prior art product was made by a different process." See In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See also In re Brown, 173 USPQ 688, 688 (CCPA 1977); In re Fessman, 180 USPQ 324, 326 (CCPA 1977); and see also MPEP 2113.

Allowable Subject Matter

10. Claims 39-43, 51-57, & 59 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Applicants' Arguments

11. Applicants' amendment/response filed on September 07, 2004 has been reconsidered, but not deemed persuasive in view of the new ground of rejections above.

Citations

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 Form prepared attached. All reference cited are for related art.

Conclusion

13. Claims 34-61 are pending in the application. Claims 34-38, 44-50, 58, & 60-61 are rejected. Claims 34, 39-43, 51-57, & 59 are objected. No claims are allowed.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Cam Nguyen, whose telephone number is (571) 272-1357. The examiner can normally be reached on M-F from 9:30 am. to 6:00 pm.

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The appropriate fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to telephone number (571) 272-1700.

Nguyen/cnn



November 29, 2004


CAM N. NGUYEN
PRIMARY EXAMINER

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